

REMARKS

The rejection of claims 1, 2, 4, 7, and 9 under 35 U.S.C. §102(b) as being anticipated by Powell is respectfully traversed. All applicant's remarks against Powell previously filed are renewed and incorporated herein by reference.

Applicant's specification clearly shows that applicant's use of the term "placing bets thereupon" means placing physical betting objects upon the numbered indicia of the table. Page 8, lines 5-6, describes how players make bets "on the table layout 6," which was previously described on page 6, lines 15-17, as being only slightly different from a conventional roulette table layout. Also applicant's Fig.1 shows chips for placing bets on the table's numbered indicia. The application does not even hint at making bets by "touching numbers."

Moreover, since an object of applicant's invention (and thus a problem solved by applicant) is to provide a game which can be played by conventional roulette rules (page 3, lines 14-16), and according to conventional roulette rules, a hopefully winning number is selected by placing one or more chips on the number, and the size of the bet is indicated by the quantity of the chips placed upon the number. Therefore applicant's term "placing bets thereupon" involves two things: (1) selection of a hopefully winning number, and (2) stating the size of the bet. However, in the context of applicant's specification and the problem he solved, a player merely touching numbered buttons or surfaces, like on Powell's panel 72, would not be able to both select a number and state the size of the bet. In other words, the player would only be able to select the number upon which the player is betting, but not the size of the bet. Powell even describes his panel 72 as being limited to selecting only a winning number: "The control panel 72 allows a user to program numbers that the user will guess as to be the winning lottery balls 46 that will be pulled from the ball dispenser 38." The panel 72 is described as having technology similar to a calculator or computer and having push buttons to facilitate its use "to program numbers that the user will guess as to be the winning lottery balls" (Col. 5, lines 19-24). So Powell's panel 72 cannot be used for placing bets in the context of roulette rules - it can be used to pick a hopefully winning number but it cannot also be used for entering the size of the bet. Therefore Powell cannot anticipate the subject claims because Powell does not disclose "number indicia for placing bets thereupon."

not clear

Additionally, as explained previously, claim 1 has a display “for displaying the selected number” (singular), whereas Powell has a display for displaying the numbers (plural) the user guesses will be selected, (not the actual numbers selected) (Col 5, lines 19-33).

The rejection of claim 1 under 35 U.S.C. §102(e) as being anticipated by Perrie is respectfully traversed. All applicant’s remarks against Perrie previously filed are renewed and incorporated herein by reference.

In addition, Perrie lacks “number indicia for placing bets thereupon” for the same reasons as explained above for Powell. Pierre’s area 50 is a video touch screen; players indicate hopefully winning “group” by “touching” the appropriate group areas. See Col. 8, lines 11-14. So unlike claim 1(a), area 50 is not an area “for placing bets thereupon” because it cannot also be used for stating the size of a bet. For these reasons Pierre does not anticipate claim 1.

1st bet
up
not
linked

The rejection of Claims 3 and 8 under 35 U.S.C. §103(a) as being unpatentable over Powell is respectfully traversed. The remarks previously made above regarding Powell are applicable to this rejection and are incorporated herein as though set out in full. Powell does not teach nor even suggest “number indicia for placing bets thereupon” in the context of conventional roulette betting rules, i.e., making a bet by (1) placing one or more chips on a number, and (2) stating the size of the bet by the quantity of chips placed. Furthermore, there is no need or reason for Powell to have a table for the placing of chips on numbers, since his game is a lottery game and so there is no suggestion in Powell to include “number indicia for placing bets thereupon.”

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

For the above reasons, Powell does not teach or even suggest all limitations of the subject claims. For these reasons, claims 3 and 8 are not made obvious by Powell.

The rejection of Claim 5 under 35 U.S.C. §103(a) as being unpatentable over Powell in view of Kuhlman is respectfully traversed. The remarks previously made above regarding Powell are applicable to this rejection, particularly those showing the inapplicability of Powell, and are incorporated herein by reference as though set out in full.

Also, Kuhlman cannot be used as a 103(a) reference because it had not issued when applicant filed his provisional application (60/189,544 March 15, 2000) upon which this application is based. Therefore clearly Kuhlman presents no evidence of the level of skill in the pertinent art on March 15, 2000 because it had not yet been published.

Also with respect to Kuhlman, applicant has requested that the examiner provide an affidavit regarding his comment that, "Examiner views such limitations to be commonly known in the art area." as called-for in the MPEP, section 2144.03 stating specifically all evidence, data and facts in support of his comment. The examiner has not supplied such affidavit. The request for an affidavit is hereby renewed.

The rejection of claim 6 under 35 U.S.C. §103(a) as being unpatentable over Powell in view of Orselli is respectfully traversed. All the remarks previously made above regarding Powell and Orselli are applicable to this rejection, particularly those showing the inapplicability of Powell, and are incorporated herein as though set out in full.

As explained previously, Powell is clearly limited as to the number of players, and it would make no sense to incorporate the expensive roulette setup of Orselli for such a small player group. Moreover Powell is designed to simulate a lottery which is a very different game from roulette. There would be no incentive to incorporate a roulette table and roulette indicia for a simple lottery game. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

Furthermore, there would be no motivation, nor is there any suggestion in Powell, to increase the size of his panel 72 to accommodate 39 (1-38) buttons or touch surfaces since there never was, nor will there ever be, a lottery in which players must guess at a 68-digit number. The odds of winning such a lottery would be one in infinity, i.e., effectively zero. No one would ever

win! So obviously no one would ever play Powell's modified game. (The 68 digits is calculated by summing the single digits of the numbers 0-9 with the double digits of the numbers 10-38.)

Also with respect to Orselli, applicant has requested that the examiner provide an affidavit regarding his statement that it would be a "choice of preference of the house" as called-for in the MPEP, section 2144.03 stating specifically all evidence, data and facts in support of his statement. The examiner has not supplied such affidavit, nor has he addressed it. The request for an affidavit is hereby renewed.

The rejection of claims 10 and 11 under 35 U.S.C. §103(a) as being unpatentable over Powell in view of Levy is respectfully traversed. All the remarks previously made above regarding Powell and Levy are applicable to this rejection, particularly those showing the inapplicability of Powell, and are incorporated herein as though set out in full.

Levy does not make claims 10 or 11 obvious. In Levy the random number generator is a pair of dice rolled by a player at a table in a casino, the play received by closed circuit TV for a user making bets at a remote location. Levy does not control the random number generator. Applicant's invention allows the user to control the activation of the random number generator. There is nothing in Levy which suggests or discloses the controlling of the random number generator. In fact, Levy specifically points out that the random number generator (the player rolling the dice) is disinterested and the possibilities of a rigged game are minimized (Col. 5, lines 19-26). For this reason Levy has no motive or teaching of the control of the random number generator. In fact, as noted Levy teaches away from any control of the random number generator. For these reasons Claims 10 and 11 are not made obvious by Powell and Levy.

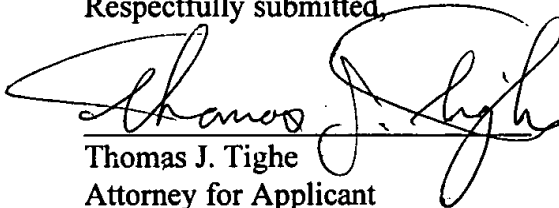
The rejection of claims 12 and 13 under 35 U.S.C. §103(a) as being unpatentable over Powell in view of Huard is respectfully traversed. All the remarks previously made above regarding Powell and Huard are applicable to this rejection, particularly those showing the inapplicability of Powell, and are incorporated herein as though set out in full.

Huard does not make claims 12 or 13 obvious. In Huard a device is used to pick a card at random using a mechanical card selection device, whereas applicant's invention uses a

mechanical shuffler for arranging the cards in a random sequence prior to picking a card from the shuffled deck. While Huard also uses a computer to randomly pick a "magic card" from a virtual deck of cards, there is nothing to suggest or disclose the use of a mechanical shuffler for arranging the cards in a random sequence prior to picking a card from the shuffled deck. Furthermore, using cards as only a random number generator is not disclosed in the prior art, nor is it suggested by Huard. This is because cards require a great number of shuffles before their arrangement can be considered random. In fact it is an unknown as to how many shuffles are required for a true random sequence. Also the stickiness of the cards comes into play. Moreover the skill of the shuffler comes into play. A poor shuffler could shuffle all day before achieving true randomness. This is very time consuming and would be impractical for use in a truly random number game. Additionally, while Huard discloses a display for a picked "magic card" from a virtual card deck as generated by the software in the computer, since this can be done without the use of a camera, there is nothing to suggest or disclose the displaying of a card or cards selected from a real card deck. Claims 12 and 13 are not made obvious by Powell or Huard.

It is believed the application is now in a condition for allowance, and reconsideration of this application is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Thomas J. Tighe", written over a horizontal line.

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